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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,120	05/25/2001	Tommy C. Poon	MH-5077	4933

7590 09/23/2002

Patent Department
Mitsubishi Electric Research Laboratories, Inc.
201 Broadway
Cambridge, MA 02139

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/866,120

Applicant(s)
Poon

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 25, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear in claim 6 from limitation of,

“ a personal access module connected to the network for specifying a commercial transaction for a particular”,

what the commercial transaction is specified for.

3. Claim 6 recites the limitation "the user" in lines 5, 7 and 9 respectively. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, Examiner considers the limitations "--the user--" to be "--a user--".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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1 5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli
2 (US 5,758,328) in view of Sixtus (US 5,903,721).

3
4 **Regarding Claims 1 and 6:**

5 Giovannoli discloses a method for performing a commercial transaction via a network (see
6 Giovannoli, Abstract):

7 specifying a commercial transaction (*request*) for a particular user in a personal access
8 module (*computer*) connected to the network (*Internet*) (see Giovannoli, fig. 4, col. 2, ll. 35-
9 51);

10 receiving the commercial transaction (*request*) in a personal access link configured to
11 operate according to a profile associated with the user (see Giovannoli, col. 2, ll. 51 to col. 3,
12 ll. 4; and col. 3, ll. 55+);

13 Giovannoli fails to disclose forwarding the commercial transaction to a financial
14 institution system depending on the profile of the user and forwarding the commercial
15 transaction from the financial institution system to a selected merchant system depending on
16 the profile of the user and the commercial transaction. These features are found in Sixtus (see
17 Sixtus, col. 6, ll. 32 to col. 7, ll. 10). It would have been obvious for an artisan of ordinary
18 skill at the time of the invention of Giovannoli to provide the aforementioned features as taught
19 in Sixtus, because an artisan at the time of the invention would recognize the convenience of
20 providing electronic payment for items over the network once the request had been made and
21 accepted by the merchant. Furthermore, a transaction between a user and a merchant wherein
22 the financial institution would have provided greater security, and thus greater confidence for

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1 those parties using the system. Thus such a modification would have been an obvious
2 expedient to one of ordinary skill in the art.

3
4 **Regarding Claim 2:**

5 Giovannoli in view of Sixtus discloses that the user profile is generated and updated using a
6 mobile agent (see Sixtus, col. 7, col. 54+).

7
8 **Regarding Claim 3:**

9 Giovannoli in view of Sixtus discloses the personal access module identifies the user and a
10 method of payment

11
12
13 **Regarding Claim 4:**

14 Giovannoli in view of Sixtus discloses the personal access link is a web site operated by the
15 financial institutional system (see Sixtus, col. 6, ll. 33 to col. 7, ll. 11; col. 7, 54+).

16
17 **Regarding Claim 5:**

18 Giovannoli in view of Sixtus discloses the financial institution system is coupled to a plurality
19 of merchant systems (see Sixtus, col. 6, ll. 8-13).

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

7. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3 

4 DSF

5 September 17, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600